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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,761	01/26/2004	Michael Alan Siecke	44150/182	8779
1912 7590 09/05/2007 AMSTER, ROTHSTEIN & EBENSTEIN LLP 90 PARK AVENUE NEW YORK, NY 10016			EXAMINER BUI, LUAN KIM	
			ART UNIT 3728	PAPER NUMBER
			MAIL DATE 09/05/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/764,761	Applicant(s) SIECKE, MICHAEL ALAN	
	Examiner Luan K. Bui	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-10 and 12-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 and 23 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10, 12-21, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Prosecution Application***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/30/2007 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 5, 6, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cetrelli (4,559,259) in view of Weber (2,634,046) and Kosterka (3,556,391). Cetrelli discloses a blank comprising an unfolded sheet of paper (Figure 1) defining a first face and a second face opposite the first face. The first face is flat and coated with a thermoplastic material (column 3, lines 54-57), the second face is unprinted and having at least one pair of adjacent parallel grooves (6). The blank is further comprising a foldline (8) extending along a horizontal midline (rotate the blank of Figure 1 in 90 degree) thereof transverse to the at least one pair of parallel grooves. Cetrelli also discloses the other limitations of the claims except for the first face being printed and the grooves being cut-out grooves.

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Weber teaches a blank comprising an unfolded sheet of cardboard/paperboard material defining a first face and a second face opposite the first face, the first face being flat, coated (a) and printed (column 1, line 11) and the second face being unprinted and defining at least one pair of adjacent parallel cut-out grooves (2, 5; column 2, lines 35-39). Kosterka shows a blank (11) comprising an unfolded sheet (Figure 1) defining a first face and a second face with at least one of the faces is printed (column 2, lines 53-56) and a foldline (26) extending along a horizontal midline.

It would have been obvious to one having ordinary skill in the art in view of Weber and Kosterka to modify the blank of Cetrelli so the first face is also printed to provide more convenience for the user and because such printed information on the blank is old and conventional in the art.

With respect to the grooves, whether the grooves formed by the method as shown by Cetrelli or formed by cut-out as taught by Weber, it would have been obvious to one having ordinary skill in the art to modify the grooves of Cetrelli so the grooves formed by cut-out grooves as taught by Weber because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Regarding the material of the blank of Cetrelli, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the blank of Cetrelli so it formed from paperboard in lieu of paper as taught by Weber since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

As to claims 1 and 24, see the blank of Cetrelli as modified above.

As to claim 25, the blank as shown in Figure 1 of Cetrelli as modified is considered equivalent to a paperboard component as claimed since the component as recited in the claim 25 is considered

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as one part of the blank that formed the package and a folded line (7) is considered equivalent to the folded line as claimed to form a concealed inner face that defined at least one groove (Figure 3).

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Kuchenbecker (4,740,163). Cetrelli further fails to show the grooves being formed by laser. Kuchenbecker teaches a paperboard blank for forming a package comprising channels/grooves (25, 26) formed by laser. It would have been obvious to one having ordinary skill in the art in view of Kuchenbecker to modify the grooves of Cetrelli so the grooves are formed by laser for better removing the material from the blank.

5. Claims 4 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Voss (5,427,309). Cetrelli further fails to show the second face being defined at least two spaced apart pairs of parallel grooves. Voss shows a blank (10) having at least two spaced apart pairs of parallel grooves (37-42) (Figure 8). It would have been obvious to one having ordinary skill in the art in view of Voss to modify the blank of Cetrelli as modified so the second face comprises at least two spaced apart pairs of parallel grooves to facilitate folding.

6. Claims 12, 13, 15-17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cetrelli (4,559,259) in view of Weber (2,634,046) and Matsuoka (6,761,307). Cetrelli discloses a package comprising a paper component (Figure 1) formed of blank folded

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along a horizontal midline (7) to define a double thickness with an exposed outer face thereof is coated, a concealed inner face thereof is unprinted and the concealed inner face defining at least one groove (6, Figure 3). Cetrelli also discloses the other claimed limitations except for the outer face being printed and the concealed inner face comprises at least one pair of adjacent parallel cut-out grooves.

Weber teaches a blank for forming a package comprising an unfolded sheet of cardboard/paperboard material defining an outer face and an inner face opposite the outer face, the outer face being flat, coated (a) and printed (column 1, line 11) and at least one pair of adjacent parallel cut-out grooves (2, 5; column 2, lines 35-39). Matsuoka teaches a package comprising a component (4b, 9a, Figures 1 & 3) formed of a blank folded along a fold line to form a concealed inner face defining at least one pair of adjacent parallel grooves.

It would have been obvious to one having ordinary skill in the art in view of Weber and Matsuoka to modify the package of Cetrelli so the outer face is also printed as taught by Weber to provide more convenience for the user and because such printed information on the blank is old and conventional in the art and the concealed inner face comprises at least one pair of adjacent parallel grooves as taught by Matsuoka to facilitate folding the blank of Cetrelli to form the package.

With respect to the grooves, whether the grooves formed by the method as shown by Cetrelli or formed by cut-out as taught by Weber, it would have been obvious to one having ordinary skill in the art to modify the grooves of Cetrelli so the grooves formed by cut-out grooves as taught by Weber because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

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Regarding the material of the blank of Cetrelli, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the blank of Cetrelli so it formed from paperboard in lieu of paper as taught by Weber since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

As to claims 15 and 19, it would have been obvious to one having ordinary skill in the art in view of the package of Cetrelli as modified so the concealed inner face comprises at least two or three spaced apart pair of parallel grooves since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 12 above, and further in view of Kuchenbecker (4,740,163). Cetrelli further fails to show the grooves being formed by laser. Kuchenbecker teaches a paperboard blank for forming a package comprising channels/grooves (25, 26) formed by laser. It would have been obvious to one having ordinary skill in the art in view of Kuchenbecker to modify the grooves of Cetrelli so the grooves are formed by laser for better removing the material from the blank.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of The Official Notice. Cetrelli further fails to show the outer face comprises at least one plastic component. The Official Notice is taken of the old and conventional practice of providing a package comprising a plastic envelope/plastic component attached to an outer face of the package for holding information for mailing the

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package and such package is conventional used by the U.S. Postal Service. It would have been obvious to one having ordinary skill in the art in view of The Official Notice to modify the package of Cetrelli as modified so the outer face of the package includes a plastic envelope/plastic component for holding information. The plastic envelope/plastic component of Cetrelli as modified is capable to receive a recording medium.

### ***Response to Arguments***

Applicant's arguments with respect to the pending claims have been considered but are deemed to be moot in view of the new grounds of rejection.

Applicant's arguments with respect to Cetrelli in the remarks are noted. They are not persuasive for the reasons as set forth above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is 571-272-4552. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

lkb  
September 2, 2007

/Luan K. Bui/  
Primary Examiner  
Art Unit 3728